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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/313,534 05/13/99 ROMERO

A 4830.P-RE

EXAMINER

HM12/0125

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INTELLECTUAL PROPERTY LEGAL SERVICES  
PHARMACIA & UPJOHN COMPANY  
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MORRIS, P

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

01/25/01

01/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/313,534

Applicant(s)

Ramero

Examiner

J. Morris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.  
Of the above claim(s) 9-12 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Reissue Applications***

Claims 1-8 are consideration in this application.

Claims 9-12 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

### ***Continued Prosecution Application***

The request filed on December 11, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/313,534 is acceptable and a CPA has been established. An action on the CPA follows.

Applicant's communication filed December 11, 2000 is noted. **To clarify the record, there was never any formal interview of December 4, 2000 with the alleged attorney of record. The examiner NEVER AGREED that the filing of the present CPA, after two years from the grant of the original patent would have no impact on the applicants' right to file to enlarge the scope of the claims, that are subject of the instant reissue. This is a false and inaccurate allegation by applicants.**

A CPA is a technically/legally a new application. Hence, applicant has now added an additional issue of broadening the claims outside the two year period. Further, new rule 37 CFR 1.176 is applicable herein.

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***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to compounds, composition and use, classified in class 514, subclass 292.
- II. Claim 9, drawn to an intermediate, classified in class 546, subclass 158.
- III. Claim 10, drawn to an intermediate, classified in class 546, subclass 159.
- IV. Claim 11, drawn to an intermediate, classified in class 546, subclass 162.
- V. Claim 12, drawn to an intermediate, classified in class 546, subclass 84.

These distinct inventions have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, restriction for examination purposes as indicated is considered proper; 35 U.S.C. 121; 37 CFR 1.141; 37 CFR 1.142.

Inventions I and II-V are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as herbicides, fungicides, bactericides, insecticides, etc., and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably

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distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The subject matter of the original patent claims are held to be constructively elected. Hence, claims 9-12 are held withdrawn from consideration as being drawn to nonelected subject matter.

The reissue oath or declaration filed December 11, 2000 application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and see MPEP 1414.

The reissue statute - 35 U.S.C. 251 - provides for the reissue of patents whenever the patent is deemed wholly or partly inoperative or invalid through error without any deceptive intention. Applicant fails to allege that the original patent is inoperative or invalid or fails to state the reason of a defective specification, or of patentee claiming more or less that patentee had the right to claim in the patent.

Applicant now merely asserts in the declaration filed December 11, 2000 that applicant failed to claim intermediates. Applicant has added claims directed to inventions which are

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**separate and distinct from the invention defined by the original patent claims.** This has been clearly set forth in the record. The Office does not allow a reissue patent which does not correct any error in the original patent. Note 37 CFR 1.145 and new rule 1.176 effective November 7, 2000.

Again, the reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. There is no error in the original patent claims.

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

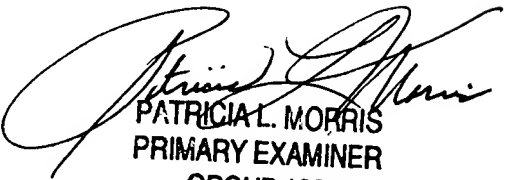
Claims 1-8 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

As clearly set forth above, there is no error in the original patent claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

plm

January 24, 2001

  
PATRICIA L. MORRIS  
PRIMARY EXAMINER  
GROUP 120